

REMARKS

Claims 1, 2, 11, 13, 14, 18, 26 and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Stallings, William. *Cryptography and Network Security*; Third Edition. Chapter 9 / Public-Key Cryptography: 9.1: Principles of Public-Key Cryptosystems, hereinafter *Stallings*. Claims 3, 5, 9, 10, 15, 16, 19 and 20 were rejected under 35 U.S.C § 103(a) as being obvious in view of *Stallings*, in view of Bentley (.S. Pat. Pub. No. 2003/0217275), hereinafter *Bentley*. Claims 6-8 were rejected under 35 U.S.C § 103(a) as being obvious in view of *Stallings* and *Bentley*, and further in view of VanHeyningen et al. (U.S. Pat. No.2002/0112152), hereinafter *VanHeyningen*. Claims 28 was rejected under 35 U.S.C § 103(a) as being obvious in view of *Stallings* and *Bentley*, and further in view Wasilewski et al (U.S. Pat. No. 5,870,474), hereinafter *Wasilewski*. Claims 22-25 were rejected under 35 U.S.C § 103(a) as being obvious in view of *Stallings* and *Bentley*, and *VanHeyningen*, in view of *Wasilewski*.¹

By this amendment claims 1, 14, 18, 22, 26, and 27 have been amended.² Claim 3 has been cancelled. Accordingly, claims 1-2, 5-11, 14-16, 18-26, 27-28 are pending, of which claims 1, 14, 18, 21, 22, 25, 26, and 27 are the only independent claims at issue.

Applicants respectfully submit that the cited art of record does not anticipate or otherwise render the amended claims unpatentable for at least the reason that the cited art does not disclose, suggest, or enable each and every element of these claims.

35 U.S.C. 102 and 103 Rejections

Each of the claims as now amended recites an element directed to using a remote service binding which specifies a remote service by using the logical address of the remote service such that the binding is not dependent on the physical location of the service or the number of instances of the service that are deployed. For example, claim 1 recites: "the remote service binding specifying: the remote service by specifying a logical address of the remote service such that the binding is not dependent on the physical location of the service or the number of instances of the service that are deployed..." Each of the other independent claims recites "the remote service binding specifying a logical address of the remote service such that the binding is

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

² Support for the amendments to the claims and for the new claims is found throughout the specification and previously presented claims, including but not limited to page 6, lines 5-18, page 8, lines 22-24, page 13, line 25 – page 16, line 6.

not dependent on the physical location of the service or the number of instances of the service that are deployed....” These elements are simply not taught or made obvious by the cited art.

In particular, with respect to now cancelled claim 3, the Office Action cites to Bentley at paragraph [0090] for showing that a remote service binding allows an application to address the remote service using a logical name. However, Applicant respectfully traverses this characterization of Bentley as well as the stated motivation for combining Bentley with the primary reference Stallings.

In particular, Bentley at [0090] teaches that “a signature cell includes 1) the logical name of the signature [and] 2) a graphic to represent the signature visually....” Bentley further teaches that “a user who wishes to place a signature in a document can select a signature cell from a cell library based on the signature cells logical name and its appearance.” However, this is significantly different from what is recited by the claims, and in some cases appears to teach almost the opposite of what is recited. Namely, claim 1 recites “a binding component that creates a remote service binding between a user's digital certificate and a remote service associated with a target system, the remote service binding specifying: the remote service by specifying a logical address of the remote service....” Rather than showing a logical name of a remote service, Bentley teaches the logical name of a signature. Similarly, claims 14, 18, 22, 26, and 27 each recite “the remote service binding specifying a logical address of the remote service....” This is simply not shown by Bentley.

Further, the stated motivation for combining Bentley with Stallings is improper in that it does not comply with recent Supreme Court precedent and Patent Office guidelines. For making the combination, the Office Action states “[t]herefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Stallings by the remote service binding allows an application to address the remote service by using a logical name as taught by Bentley for the benefit of streamlining the process of creating signatures and improving quality control.” However, the Graham factors, such as determining the level of skill in the art, an appropriate reasoning, and appropriate findings have not been made. The statements made in the Office Action do not comply with the requirements in view of recent Supreme Court precedent as set forth in the MPEPs discussion of *KSR v. Teleflex* 550 U.S. 398 as discussed at MPEP 2141 and 2143. In particular:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. ...[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

A number of rationales are given in MPEP 2141 and 2143³, however, the statements made for combining the references do not appear to fall into any of these rationales. Further, there are a number of finding of fact, which should be made explicit for the combination to be proper. For example, if a rejection is being made on the rationale of a simple substitution of one known element for another to obtain predictable results, Office personnel must resolve the *Graham* factual inquires and articulate the following:

- (1) a finding that the prior art contained a device (method, product, etc.) which differed from the claimed device by the substitution of some components (step, element, etc.) with other components;
- (2) a finding that the substituted components and their functions were known in the art;
- (3) a finding that one of ordinary skill in the art could have substituted one known element for another, and the results of the substitution would have been predictable; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

"If any of these finding cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art." Thus,

³ The rationales listed include: (A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

because the findings have not been made, no appropriate rationale has been stated. Further, because a prima facie case of obviousness has not been made, the next action may not be made final.

Because each of the dependent claims depend from one of claims 1, 14, 18, 22, 26, and 27 each of the dependent claims also patentably define over the art of record for at least the same reasons.

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (801) 533-9800.

Dated this 12th day of August, 2009.

Respectfully submitted,

/J. LAVAR OLDHAM/

RICK D. NYDEGGER
Registration No. 28,651
J. LAVAR OLDHAM
Registration No. 53,409
Attorneys for Applicant
Customer No. 47973

RDN:JLO:laf
2457960_1.DOC